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10/077,128	02/14/2002	Daniel C. Castle	10014745-1	2893

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EXAMINER

LAM, ANDREW H

ART UNIT PAPER NUMBER

2624

DATE MAILED: 08/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/077,128

Applicant(s)

CASTLE, DANIEL C.

Examiner

Andrew H. Lam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/14/2002</u> . | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 6-15, 17 and 19-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Miura et al (U.S. Patent No. 6,862,103) hereinafter Miura.

Regarding claim 1, Miura discloses a system (fig. 9, diagram of the network print system) for generating a personalized publication, comprising: a processor; and a memory, coupled to the processor (fig. 9, client 101 is an information processing apparatus such as a personal computer or the like--inherently personal computer have memory that is coupled to the processor with instruction on how to process tasks), the memory containing instructions that when executed by the processor cause the processor to receive information identifying a background template and a foreground image (col. 10, lines 9-13, the browser is used to send request to the server to retrieve data which is the template and the image data); acquiring the background image from a network resource (col. 10, lines 30-33, a form template storage unit 108 stores form templates--the server sends an HTML document corresponding to a given form

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template to the client); acquiring the foreground image from a network resource (col. 10, lines 40-43, data storage unit 109 is a database for storing task data, which is the foreground data that is to be inserted into the template) ; and merging the background template and the foreground image (col. 13, lines 25-26, the form template and data are merged).

Regarding claim 2, Miura discloses the system of claim 1, wherein the processor further includes means (fig. 9, network 105, is used to connect the client to the server for acquiring the template and image data) for connecting to the network resource for acquiring the background template and the foreground 6853461 image.

Regarding claim 3, Miura discloses the system of claim 1, wherein the processor further includes a staging area (fig. 9, image generation servers 908 and 909) for maintaining the merged background template and foreground image (col. 15, lines 24-25, merging of data and form template).

Regarding claim 6, Miura discloses the system of claim 1, wherein the instructions when executed by the processor further cause the processor to connect to a transmission medium (fig. 9, network 105) and transmit the merged background template and foreground image along the transmission medium (col 12, line 1, the web browser is used to display the received data which is transmitted via the network 105 to the client 101).

Regarding claim 7, Miura discloses a method for generating a personalized publication, comprising:

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(a) retrieving a background image including foreground information image (col. 10, lines 9-13, the browser is used to send request to the server to retrieve data which is the template and the image data), the foreground information being identified by a unique identifier (col. 11, lines 29, a URL of the document);

(b) retrieving content to be maintained as the foreground information (col. 11, lines 47-51, the server searches the data storage unit 10 using the selected person name and table as keys at the designated URL to acquire data); and

(c) merging the foreground information and the background image (col. 13, lines 25-26, the form template and data are merged).

Regarding claim 8, Miura discloses the method of claim 7, further comprising: (d) storing the merged foreground information and background image in a delivery area (col. 12, lines 43-48, the retrieved template and image data are stored in memory in the server).

Regarding claim 9, Miura discloses the method of claim 8, further comprising: (e) delivering the merged foreground information and background image to a requesting location (col. 13, lines 64-65, the data generated in step S706 is sent to the client which is the requesting location).

Regarding claim 10, Miura discloses the method of claim 9, wherein the requesting location is a client station (col. 13, lines 64-65, the data generated in step S706 is sent to the client which is the requesting location).

Regarding claim 11, Miura discloses the method of claim 7, further comprising receiving a request for merged information, the request for receiving the merged information being performed before the merging step (fig. 5, shows

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the client requesting the data to be printed, S501 to S504 are steps for retrieving the template and data before the merging is done in S505).

Regarding claim 12, Miura discloses the method of claim 7, wherein the background image comprises a template (col. 12, line 19, fig. 3, shows an example of the form template used as the background image).

Regarding claim 13, Miura discloses the method of claim 7, wherein the foreground information retrieving step comprises:

(b1) accessing a user-defined file from a network resource (fig. 9, foreground data is stored in the data storage unit 109); and

(b2) storing the user-defined file in a staging area (col. 12, lines 43-48, the retrieved template and image data are stored in memory in the server).

Regarding claim 14, Miura discloses the method of claim 13, wherein the user-defined file comprises one of the following: an image, a comic strip and a quote (col.10, lines 40-41, data storage 109 is a database or the like and stores task data--it is known in the art that database can be used to store data, which can be text or graphic and that graphic can be merge with template).

Regarding claim 15, Miura discloses the method of claim 7, wherein the background image retrieving step further comprises:

(a1) accessing a network resource containing a plurality of background images (fig. 9, templates are stored in the form templates storage unit 108); and

(a2) retrieving a user-defined background image from one of the plurality of background images (fig. 5, S502 a request is made to search for a specific template); and

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(a3) storing the user-defined background image in a staging area (col. 12, lines 43-48, the retrieved template and image data are stored in memory in the server).

Regarding claim 17, Miura discloses a method for generating a personalized electronic document, comprising:

(a) receiving information identifying a background template and a foreground image (fig. 2, shows a browser where a user can select the background template and the foreground image);

(b) acquiring the background template from a network resource (fig. 9, form templates storage unit 108 is used to store templates where a user can select to use as the background);

(c) acquiring the foreground image from a network resource (fig.9, data storage unit 109 is used to store data where a user can select to use to merge with the background); and

(d) merging the background template and the foreground image (col. 13, lines 25-26, the form template and data are merged).

Regarding claim 19, Miura discloses the method of claim 17, wherein the information receiving step further comprises:

(a1) receiving a background type identifier (col. 11, line 53, the name of the form is select by the user which is the identifier of the template to be used, see fig. 2, selection fields 206); and

(a2) receiving foreground image placement information (col. 12, lines 64-65, the position of variable data fields to be merged with the form template);

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Regarding claim 20, Miura discloses the method of claim 19, further comprising:

(a3) receiving a foreground image identifier (col. 11, line 52, the person name is the identifier of the foreground image to be used, see fig. 2, selection fields 207).

Regarding claim 21, Miura discloses the method of claim 17, wherein the foreground image is identified as being one of the following: a comic, an image, a quote (col.10, lines 40-41, data storage 109 is a database or the like and stores task data--it is known in the art that database can be used to store data, which can be text or graphic and that graphic can be merge with template).

Regarding claim 22, Miura discloses the method of claim 19, wherein the foreground image placement information causes the foreground image to be positioned along the top (fig. 3, monthly report of overtime work 301 is place on the top of the template), bottom, or side portions of the background template.

Regarding claim 23, Miura discloses the method of claim 19, wherein the foreground image placement information causes the foreground image to be positioned about the central portion of the background template (fig. 3, shows the frame 302 which is placed about the central portion of the background template, the foreground data that goes inside the frame is therefore about the central portion of the template).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 5, 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miura in view of Gibson (U.S. Patent No. 5,761,684).

Regarding claim 4, Miura discloses the system of claim 1, wherein the servers merge the background and foreground image together and sent to the merged data to the client (see, fig. 5).

Miura does not disclose expressly that memory further contains instructions that when executed by the processor causes the processor to receive information defining a date for transmitting the merged background template and foreground image to a client.

Gibson discloses a system for publishing and delivering the personalized document according to the publishing and delivery schedules (col. 14, lines 45-51).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Miura as per teaching of Gibson because of the following reason: by being able to schedule the deliver of merged data over a network at a scheduled time or interval would have be convenient for the user so that he/she does not have to come back to the server and input the same information therefore saving the user time.

Regarding claim 5, the combination of Miura and Gibson discloses the system of claim 4, wherein the processor further includes a delivery area (Miura,

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col. 12, lines 43-48, the retrieved template and image data are stored in memory in the server) for maintaining the merged background template and foreground image before being transmitted in response to the transmission date.

Regarding claim 16, Miura discloses the system of claim 9, wherein the servers merge the background and foreground image together and sent to the merged data to the client (see, fig. 5).

Miura does not disclose expressly that memory further contains instructions that when executed by the processor causes the processor to receive information defining a date for transmitting the merged background template and foreground image to a client.

Gibson discloses a system for publishing and delivering the personalized document according to the publishing and delivery schedules (col. 14, lines 45-51).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Miura as per teaching of Gibson because of the following reason: by being able to schedule the deliver of merged data over a network at a scheduled time or interval would have be convenient for the user so that he/she does not have to come back to the server and input the same information therefore saving the user time.

Regarding claim 18, Miura discloses the system of claim 17, wherein the servers merge the background and foreground image together and sent to the merged data to the client (see, fig. 5).

Miura does not disclose expressly that memory further contains instructions that when executed by the processor causes the processor to receive information defining a date for transmitting the merged background template and foreground image to a client.

Gibson discloses a system for publishing and delivering the personalized document according to the publishing and delivery schedules (col. 14, lines 45-51).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Miura as per teaching of Gibson because of the following reason: by being able to schedule the deliver of merged data over a network at a scheduled time or interval would have be convenient for the user so that he/she does not have to come back to the server and input the same information therefore saving the user time.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew H. Lam whose telephone number is (571) 272-8569. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR

only. For more information about the PAIR system, see [http://pair-](http://pair-direct.uspto.gov)

[direct.uspto.gov](http://pair-direct.uspto.gov). Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free).

A handwritten signature in black ink, appearing to read "David Moore". The signature is fluid and cursive, with the first name "David" and last name "Moore" clearly distinguishable.

DAVID MOORE
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